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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/630,478	07/30/2003	Patricio Nilo	1065.43	9198

7590 01/09/2006

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EXAMINER

WILSON, JOHN J

ART UNIT	PAPER NUMBER
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3732

DATE MAILED: 01/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No.	Applicant(s)	
	10/630,478	NILO ET AL.	
	Examiner	Art Unit	
	John J. Wilson	3732	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 November 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5, 8-17, 19-21, 23 and 24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 8-17, 19-21, 23 and 24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-5, 8-17, 19-21, 23 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Porter et al (6887077) in view of Lorenzi (2002/0094508). Porter shows a method of expanding bone tissue including providing multiple expanders, column 4, lines 52-64, the expanders having a shaft 52, threaded expansion tip 60 having a thread the same as the implant except the major diameter of the thread 60 is smaller than the major diameter of the thread 20 on the implant 10, column 4, lines 22-24 and lines 55-60, the method further comprising, creating an osseotomy site using a pilot drill, Fig. 4A, screwing a first threaded expander 50, fig. 3, in the site, Fig. 4C, to expand the site laterally by pushing bone tissue radially, it is noted here that in Porter, the only bone that is expanded is the bone at the threads, however, this meets the claim language of “expanding said osseotomy site laterally by pushing bone tissue away radially from a longitudinal axis”, claim 1, paragraph (c). Retrieving the tool is inherent in the shown method. Porter further shows repeating these steps, column 4, lines 55-67 and column 5, lines 27-43, see specifically, lines 37 and 38, as needed, increasing the outer diameter of the threads and therefore increasing the outer diameter of the implant site, to a diameter less than the implant, column 4, lines 22-24 and lines 55-60. Porter does not show depth markings. Lorenzi shows markings 19. It would be obvious to one of ordinary skill in the

art to modify Porter to include markings as shown by Lorenzi in order to better judge depth. To allow the expander to stay in the site for a time is an obvious matter of choice in the degree of a known parameter of compressing bone to one of ordinary skill in the art. As to claim 2, see using same thread as implant, column 4, lines 28 and 29. As to claim 4, the range of difference in diameters is an obvious matter of choice in degree of compression changes to the skilled artisan. As to claim 11, Porter does not show a ratchet. Lorenzi teaches using a drill or wrench, [0022]. It would be obvious to one of ordinary skill in the art to modify Porter to include a wrench as shown by Lorenzi in order to make use of known drivers in the art. The specific type of tool used is an obvious matter of choice in known tools to the skilled artisan. As to claim 12, see extending the site, Fig. 4B. The depth of this extension is an obvious matter of choice in the degree of the size of the implant desired. As to claim 24, see Fig. 6 of Lorenzi.

Response to Arguments

Applicant's arguments filed November 23, 2005 have been fully considered but they are not persuasive. Applicant appears to be arguing that Porter does not teach expanding the hole, however, instead is only expanding the threads, however, this argument is not commensurate with the claim language which does not distinguish. The claims do not distinguish between expanding the hole or the threads, however, instead are directed to expanding the osseotomy site. Because the hole and threads comprise the osseotomy site, expanding the threads as taught by Porter is a teaching of expanding the osseotomy site. Having met the actual claims, with respect to the disclosed invention, it is noted that Lorenzi teaches expanding the hole by using a threaded expander, however, does not show using threads that match the intended implant except that they

are narrower. Porter teaches the skilled artisan that it is known to use threads that match the implant except for being narrower.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John J. Wilson whose telephone number is 571-272-4722). The examiner can normally be reached on Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin P. Shaver, can be reached at 571-272-4720. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 3732

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



John J. Wilson
Primary Examiner
Art Unit 3732

jjw
January 4, 2006